

In the United States
Circuit Court of Appeals
For the Ninth Circuit

SAM SCHNITZER, HARRY J. WOLF, ROSE
SCHNITZER and JENNIE WOLF individu-
ally, and as a co-partnership doing business
under the name and style of ALASKA
JUNK CO.,

Appellants,

vs.

CALIFORNIA CORRUGATED CULVERT
CO., a corporation, and LEO T. CROWLEY,
Alien Property Custodian of the United
States,

Appellees.

APPELLANTS' BRIEF

Upon Appeal from the District Court of the United
States for the District of Oregon.

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Appellees.

APPELLANTS' BRIEF

Upon Appeal from the District Court of the United
States for the District of Oregon.

STATEMENT OF JURISDICTION

Jurisdiction of the District Court: This is a suit
in equity brought originally by California Corrugated
Culvert Co., a California corporation, and Karl Lan-
ninger as Plaintiffs, against Sam Schnitzer, Harry J.
Wolf, Rose Schnitzer and Jennie Wolf, individually,

and as a co-partnership doing business under the name and style of Alaska Junk Co. as Defendants, for infringement of United States Letters Patent No. 1,747,942, which issued on February 18, 1930 to Karl Lanninger, the Plaintiff, California Corrugated Culvert Co., being licensee under an exclusive license to make, use and sell the patented invention for use for irrigation purposes within the United States, and the original plaintiff, Karl Lanninger, being the owner and holder of the rights and privileges originally inuring to him under the patent other than those included in the license to the plaintiff, California Corrugated Culvert Co. Therefore, jurisdiction herein is based upon the provisions of sub-section (7) of Section 41, Title 28, U.S.C.A. and the provisions of sub-section (fifth) of Section 371, Title 28, U.S.C.A. (See Complaint, Pages 2 to 7, inclusive; Answer, Pages 8 to 14, inclusive; Supplement to Complaint, Pages 21 and 22, inclusive; and Order upon Pretrial, Pages 30 to 34, inclusive, Transcript of Record.)

Jurisdiction of the Circuit Court of Appeals: This is an appeal from an interlocutory decree of the District Court made and entered on September 9, 1942, which interlocutory decree finds infringement and refers the cause to a master to assess damages. The interlocutory decree provides that the appellees herein are, the appellee, Leo T. Crowley, as Alien Property Custodian of the United States, the owner, and the appellee, California Corrugated Culvert Co., a corporation, the holder of an exclusive license under, United

States Letters Patent No. 1,747,942 for irrigation purposes in and throughout the United States of America, which license is in force and effect; that the appellants herein have infringed claim 3 of the letters patent in suit; that the appellants be enjoined from making, using or selling the alleged infringing device; that the appellees recover from the appellants the profits, gains and advantages which the appellants have received and which may have accrued to them by reason of infringement of claim 3 of the letters patent in suit; and that the cause be referred to Irving Rand, Esq., special master, to take the accounting.

This appeal is taken pursuant to the provisions of Section 225(b) and Section 227-a, Title 28, U.S.C.A. Notice of appeal and bond on appeal were duly filed on October 1, 1942.

STATEMENT OF THE CASE

The plaintiffs allege that the original plaintiff, Karl Lanninger, was the first and sole inventor of certain alleged inventions comprising, in combination, certain elements constituting an improvement in "pipe joint", used in combination with pipe, and as more fully set forth in the claims of the patent, though the designation of the patent is that it covers "pipe line"; that on February 18, 1930 the patent in suit was granted, issued and delivered to the original plaintiff, Karl Lanninger, upon his application, Serial No. 667353, filed in the United States Patent Office on October 8,

1923, a former application having been filed in the patent office of Germany on October 14, 1922; that the plaintiff, California Corrugated Culvert Co., a California corporation, is the owner and holder of an exclusive license within the United States of America, for the manufacture, use and sale of the patented invention for use in irrigation systems; that the last named plaintiff gave notice to defendants of the inventions and the letters patent aforesaid and infringement thereof by defendants and that defendants have infringed claim 3 of said patent, this being the only claim in suit, through manufacture and sale, within the District of Oregon, within six years prior to the filing of complaint and since the granting of the letters patent aforesaid, and without the license or consent of the plaintiffs or the original plaintiff, Karl Lanninger, of pipe joints embodying the characteristics of mechanical design and construction disclosed in said letters patent and claimed in claim 3 of said letters patent. Plaintiffs further allege that the defendants, unless restrained, will continue to make, use and vend such infringing devices and further infringe claim 3 of the patent. The original plaintiffs prayed for an injunction against the infringement and for an accounting of damages.

Reference has been made to the original plaintiff, Karl Lanninger, who is an enemy alien, resident in and a citizen of Germany. On June 18, 1942 by vesting order No. 27, the substituted plaintiff and present appellee, Leo T. Crowley, as Alien Property Custodian

of the United States of America, became vested with all of the right, title and interest then and theretofore held and owned by the original plaintiff, Karl Lanninger, in and to the letters patent in suit; and by order of the trial court entered herein on August 10, 1942, said Leo T. Crowley, as Alien Property Custodian as aforesaid, was substituted as party plaintiff herein for the original party plaintiff, Karl Lanninger.

The appellants, by their answer, allege that such Letters Patent numbered 1,747,942 never validly issued from the United States Patent Office for the reasons that the pipe joint set forth in the claims of the patent, and all thereof, is not the statutory subject matter of invention, it is not a new or useful article or combination within the statutes in such case made and provided, and the alleged article or combination is not patentable subject matter under such statutes, and that the claims of said patent, and all thereof, purport to cover and cover a mere aggregation of elements; and that in view of the knowledge and practice of the art at and prior to the date of filing of the application for letters patent in the United States Patent Office for the patent in suit, it required no invention whatsoever, but only the ordinary skill of the art to which the alleged invention appertains, to make the same, and that the alleged inventions set forth in the claims of the patent, and each thereof, and every material and substantial part thereof therein claimed as new, were invented by others prior to the alleged invention thereof by the original plaintiff, Karl Lanninger, and were

shown and described in printed publications in the United States before the alleged invention thereof by the patentee of the patent in suit and for more than two years prior to the filing of the application for the patent in suit, and that the letters patent in suit were issued by the United States Patent Office without due investigation, and that an important part of the relevant prior art was overlooked, and other parts of the prior art were improperly applied and construed, by reason whereof, the Commissioner of Patents exceeded his legal authority in granting the letters patent in suit, and that the state of the art before and at the time of the alleged invention and/or application for letters patent resulting in the patent in suit, was such that to be valid, the claims of the patent in suit must be so narrowly construed as to be incapable of being validly applied to pipe joint construction, and that in view of the function, structure and purpose of the alleged invention, as claimed in the letters patent in suit, the appellees cannot seek for nor obtain a construction of the claims of the patent in suit, or any of them, sufficiently broad to cover or include within their purview, the construction employed by the appellants, and that by reason of the proceedings had and taken in the United States Patent Office in the prosecution of the application, whereon ultimately issued the patent in suit, the appellees herein are estopped from maintaining the same in such scope as to cover or embrace any apparatus which the appellants may have made, used or sold. The letters patent referred

to in the answer of the appellants as printed publications, are a list of prior United States patents (which list was amplified before trial with leave of the trial court) and such list of patents appears at page 36 of the Transcript of Record.

The appellants, by their answer, admit manufacture and sale, within the District of Oregon and within six years prior to the commencement of this proceeding and after the issue of the patent in suit, and without the license or consent of the appellees, of certain pipe joints, which pipe joints, however, they allege do not infringe claim 3 of the patent in suit.

This suit involves claim 3 only of the Lanninger patent No. 1,747,942. Claim 3 reads as follows: (Page 386, Transcript of Record)

“A pipe joint in connection with pipes one of which has an unthreaded end, a rigid coupling sleeve for coupling said pipes into which said unthreaded end extends, said sleeve having an interior annular groove in the inner surface, a packing of elastic material in said coupling sleeve consisting of a free cylindrical part frictionally enclosing the unthreaded pipe end and having a flange frictionally retained in the groove of said sleeve, and means for hingedly securing said sleeve on the pipe having the unthreaded end.”

Claim 3 is one of six claims allowed in the patent as issued.

It will be observed that all six of the claims of the patent are combination claims; all include as one of the designated elements of the combination, a pack-

ing of elastic material having a flange; and claim 3 differs from the remaining five claims of the patent in that it provides for retaining the flange of the packing *frictionally* in the sleeve, whereas, the remaining five claims provide for *clamping* the flange in the sleeve. This characteristic, taught by claim 3 of the patent in suit, of "frictionally retaining the *flange* in the groove of the sleeve" is the root from which the claim of infringement grows.

The art of coupling pipes through the medium of "bell and spigot" joints is, of course, very old. It probably has its first exemplification in the cast-iron sewer pipe joint, with which we are all familiar, where oakum or similar material and molten lead has long been the accepted medium for sealing the joint. In this type of joint, the end of neither pipe to be joined is threaded; but the male, or spigot end, is inserted into the female, or bell end, and then an appropriate sealing medium is employed.

Lanninger applied for and obtained the patent in suit, using a combination of known elements (including his "flange packing") in accomplishing his result. His device, if useful at all, which is not conceded, purported to provide an advantage in his pipe joint, in that, the joint being flexible to a degree, two adjoining pipes might be laid at angles one to the other, or moved to some degree while in use without breaking the seal. But others had provided similar, and in one instance, practically identical, means of accomplishing the same result, before Lanninger filed his patent application;

and after the patent in suit issued, others devised yet different means for accomplishing the same result.

Among these later inventors was one Ralph H. Pierce, of Eugene, Oregon.

On January 30, 1934, there issued from the United States Patent Office United States Letters Patent No. 1945293 to the said Ralph H. Pierce upon his application No. 568582, filed in the patent office on October 13, 1931. The Pierce patent had but a single claim which reads as follows :

“In a pipe joint, a sleeve member, an annular internal semi-circular section groove in said sleeve member, a cup-rubber adapted to bear in said groove and having approximate quadrants of said bearing of different radii, said cup-rubber including a dependent feather-edge lip to said cup, being thin and stretchable and adapted to conform closely to a rough surface of an inserted pipe prior to the application of internal fluid pressure.”

It will be observed that the particular characteristic of the Pierce patent is the shape and action of the packing member. It will also be observed that Pierce did not claim a means for locking the two ends of the pipe together. The Pierce patent (Exhibit 22) appears at Pages 388 to 390, inclusive, of the Transcript of Record.

The appellants in this case have purchased from the said Ralph H. Pierce pipe couplers manufactured by him and claimed to be made responsive to the disclosure of his patent No. 1945293, and have in some instances attached to such couplers, and the pipes used

in connection therewith, as a means of holding or locking the pipes together, a latch type of lock exemplified upon physical Exhibits 3 and 48. In other instances, the appellants have cut a notch in the lip, constituting the female end of the Pierce coupler, designed to receive the unthreaded or male end of pipe, and have welded upon the unthreaded end of pipe so to be received, a metal hook designed to enter such notch and, upon rotation, to engage with the lip constituting the female end of the coupler, thus forming a locking means to prevent the two pieces of pipe from pulling apart under pressure. This notch and its engaging hook are exemplified on physical Exhibits 8 and 47. See, also, Pages 31 and 32, Transcript of Record.

At the time that Lanninger filed his application in the patent office in 1923, and for very many years prior thereto (the oldest exact date appearing in this record from the various dates endorsed on Exhibits 46—a, b, c, d, e, f, being 1908) there had been in common and accepted use among manufacturers of and dealers in packings similar to that disclosed by the claims of the patent in suit and that in the alleged infringing device, and within the United States of America, certain well established trade name designations for such packings. The patentee Lanninger states expressly that his packing has a "flange". Packings responding to the shape and other characteristics of the packings described in claim 3 of the patent in suit, and disclosed by the drawings of the patent in suit, were and are known as "flange" or "hat" packings (see

Exhibits 97, 98 (Page 58 thereof), 99, 100 (Page 397 thereof), 101 (Page 52 thereof), 102 (Page 40 thereof), 103 (Pages 26 and 27 thereof), 104 (Pages 5, 6 and 8 thereof and 46—a, b, c, d, e and f.) See also the testimony of the witnesses Baldwin Vale, Pages 146, 147 and 163, and McDougall, Pages 206 and 207, and Finkbeiner, Pages 256 and 267-268, Transcript of Record.

Packings responding to the shape and other characteristics of the packing described in the claim of the Pierce patent No. 1945293 and shown in the drawings thereof, were and are known to the trade as "V" or "U" packings (see the exhibits mentioned in the next preceding paragraph and the testimony of the witnesses there named) Pages as above, Transcript of Record.

Appellees contend (and the District Court sustained them in this contention in the interlocutory decree) that the "U" or "V" type packing described in the Pierce patent No. 1945293 and included in the combination in the devices made and sold by the appellants, operates in the same manner to accomplish the same result in the same way as the flange packing described in claim 3 of the patent in suit, and that the pipe joint combinations made and sold by the appellants, including the two different means of locking the pipe ends hereinbefore detailed, therefore infringe claim 3 of the patent in suit. Appellants resist this contention and assert even should the patent in suit be held valid that by reason of the express language of claim 3 of the patent in suit as the same is ex-

plained and elaborated upon by the specifications of the patent in suit and the remaining five claims thereof and the drawings thereof; and by reason of the actions of the patent office examiners during the prosecution of the application for the patent in suit and the responses thereto by the patentee; and by reason of subsequent definition by the appellee, California Corrugated Culvert Co. of the scope of the claims of the patent in suit, the appellees herein may claim, as protected by the scope of claim 3 of the patent in suit, only combinations otherwise responding to the language of the claim and incorporating as one of the elements thereof a *flange* packing; that a flange packing on the one hand and a "U" or "V" packing on the other do not operate in the same manner; and that, therefore, there can be no infringement under the facts in this case.

Additionally—and this is most important—the facts here disclose (Pages 332 and 333 of the Transcript) that during all of the time since issue of the patent in suit, on February 18, 1930, only some *six* pipe joints actually including in the structure thereof a *flange* packing have been made by the appellees herein or either of them, when contrasted with many thousands of pipe joints made and sold annually by appellee, California Corrugated Culvert Co. wherein a round rubber ring or a "U" packing have been incorporated (see Page 333, Transcript); and the appellants, therefore, charge that the combination described in claim 3 of the patent in suit is not useful; that the patent in

suit is but a "paper patent"; and that its scope must therefore be strictly construed.

SPECIFICATIONS OF ERROR

The appellants rely upon each of the specifications of error heretofore assigned by them, as follows:

I.

The District Court erred in declining to consider proof and offered proof of anticipation of the patent in suit through prior development of analogous arts, including specifically the art of coupling hoses. (This ruling appears at Pages 197-204, inclusive, Transcript of Record.)

Transcript of Record, pages 372 and 373.

II.

The trial court erred in holding the patent in suit, and particularly claim 3 thereof, valid, when

(1) The so-called inventions and improvements which are the subject matter of the patent in suit do not involve or contain any patentable novelty, invention or discovery, and are not the statutory subject matter of invention, but on the contrary, are mere aggregation, and are not useful.

(2) The patent in suit, and particularly claim 3 thereof, was void because of anticipation and because it required no invention whatsoever, but only the ordinary skill of the art to which the alleged invention of patent in suit appertains, to make the same. (Transcript of Record, Page 373.)

III.

The District Court erred in finding and decreeing that the appellants have infringed Claim 3 of the patent in suit when:

1. By reason of the proceedings had and taken by the patentee in the patent office in the prosecution of the application for the letters patent in suit, the patentee limits himself and the claims of the patent to the use of a flange or hat packing, and in that, during the course of such prosecution of the application in the patent office, the patentee differentiated between such flange or hat packing and the "U" packing disclosed in United States letters patent to E. V. Anderson, patent numbered 811,812, issued February 6, 1906, in order to escape rejection of his claims in the patent office and to secure issue of the patent in suit, making the point in such differentiation that his invention employs a hat or flange packing, as distinguished from a "U" packing.

2. By reason of the construction placed by the appellee, California Corrugated Culvert Co., a corporation, upon the scope and extent of the claims of the patent in suit, and particularly Claim 3 thereof, which construction was communicated to and acted upon by the appellants in this suit, the appellees are estopped to assert the claims of the patent in suit, and particularly Claim 3 thereof, in scope wide enough to hold the defendants and appellants guilty of infringement.

3. The accused structure of the appellants employs and discloses a "U" or "V" packing, as distinguished from the flange or hat packing taught by the claims of the patent in suit, the structure and the modes of operation of the two types of packing being different. —

4. It ignored claim language in finding infringement. (Transcript of Record, Pages 373 and 374.)

ARGUMENT

Taking the foregoing matters up in order :

SPECIFICATION I.

As will appear from the pretrial order Page 36, Transcript, numerous patents were cited in anticipation of the claims of the patent in suit. Many of these patents do not appear in evidence nor in the record. The reason lies in the ruling of the court (Pages 197-204, Transcript of Record) that the court would not consider in anticipation prior inventions in the art of coupling hoses. Though not supported by the record (for there is no record on these patents because of the court's ruling) many of the patents cited were patents on devices for the coupling of hoses. This court has ruled, in *Bingham Pump Company, Inc. vs. Leonard L. Edwards*, 118 Fed. (2d) 338 (340) :

"It is clear that Appel did not conceive of the use of his device as appellee conceives his. How-

ever, if Appel's device can be used for the same purpose, it is immaterial whether he conceived of that use. *Dailey v. Lipman Wolfe & Co.*, 9 Cir. 88 F. (2d) 362, 364 and authorities cited. Therefore, the fact that Appel did not know that his device could be used for the same purpose as appellee's device does not preclude the defense of anticipation."

It is obvious that a hose is but a flexible pipe and a pipe but a rigid hose. For example, observe the drawings of the patent to Berry, Fig. 1 of the drawings (Page 414, Transcript) where, in effect, a pipe becomes a hose. The means employed by one man to couple a hose might certainly be employed by a second to couple a pipe; and, to the writer, there would have been no invention involved in so doing, even in the absence of this court's ruling on the lack of necessity for perception on the part of the inventor of the coupling of hoses that his invention might be also used for the coupling of pipes. It is obvious that the trial court, by this ruling, precluded the appellants from development of the defense of anticipation of the patent in suit through the medium of development of the teachings of anticipatory patents for the coupling of hoses.

"The question therefore is whether employing as the forward truck of a locomotive engine with fixed driving wheels, a truck already in use on railroad cars has the novelty requisite to sustain a patent. * * * *

It is settled by many decisions of this court which it is unnecessary to quote from or refer to in detail that the application of an old process or machine to a similar analogous subject with no

change in the manner of application and no result substantially distinct in its nature will not sustain a patent even if the new form of result has not before been contemplated.”

Pennsylvania Railroad v. Locomotive Co., 110 U.S. 490, 28 L. Ed. 222.

See also Hotchkiss v. Greenwood, 11 Howard 248.

Phillips v. Page, 24 Howard 164-167.

Jones v. Moorehead, 1 Wall. 155.

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Brown v. Piper, 91 U.S. 37.

Atlantic Works v. Brady, 107 U.S. 192.

Cuno Eng. Corp. v. Automatic Devices Corp., 314 U.S. 84, 91.

SPECIFICATION II.

(1) As appears from Page 24 of Exhibit 105, being a treatise upon “Water and Gas Works Appliances and Pumping Machinery”, published in 1901, the bell and spigot joint wherein the male end of an unthreaded pipe is received within the bell of a similarly unthreaded pipe end is old, dating back at least to the year 1820. The patent in suit employes this basic method of bringing the two pipe ends together. The patent to McGowan, Exhibit No. 25, issued December 2, 1879, discloses the same structure between the parts A and B in the drawing (Figure 3) (Page 392, Transcript of Record). The patent to Jones, Exhibit No. 27 (Page 396, Transcript of Record), issued July 25, 1911, dis-

closes the same structure between the parts 19 and 14 (Figures 3 and 4 of the drawings). The patent to Close, Exhibit No. 29 (Page 403, Transcript of Record) issued November 5, 1901, discloses the same structure between the parts D and B (Figure 1 of the drawings). The patent to Gorter, Exhibit No. 32 (Page 409, Transcript of Record), issued April 6, 1897, discloses the same structure between the parts B and A (Figure 1 of the drawings). The patent to Berry, Exhibit No. 36, (Page 416, Transcript of Record) issued February 5, 1918, discloses the same structure between the parts C and D (Figure 4 of the drawings). The patent to Anderson, Exhibit No. 40 (Page 438, Transcript of Record), issued February 6, 1906, discloses the same structure between the parts 6 and 5 (Figure 4 of the drawings). The patent to Serrell, Exhibit No. 39 (Page 430, Transcript of Record), issued January 28, 1919, discloses the same structure between the parts a and 1 (Figures 1 and 2 of the drawings).

As appears from the specifications in the patents to McGowan, Jones, Close, Gorter, Berry, Anderson and Serrell, above referred to, all of these inventors employed a flexible and, in all cases, elastic packing member to seal their joints. So, this feature of the combination of claim 3 of the patent in suit is also old in a broad sense.

In McGowan, above referred to, we find the annular groove in which the packing is retained at the figure K in figure 3 of the drawings and also described in the specifications; in Jones, we find the flange of

the flexible packing member (No. 22 in figure 5 of the drawings) within a joint constituting an annular groove. In Close, we find the flexible packing member described in the specifications and shown at E of figure 1 of the drawings. In Gorter, we find the annular groove described in the specifications and shown at E of figure 1 of the drawings. In Berry, we find the annular groove between the clamping rings p and q, figures 3 and 4 of the drawings, this time an external rather than an internal annular groove. In Anderson, we find the annular groove described in the specifications as a "suitable seat"; and it is exterior on the male portion instead of interior on the female portion. It is shown at 7 and 8 of figure 4 of the drawings, though these numbers apply to the packing and the spring therein contained. In Serrell, the annular groove is of a different shape and is represented in the recess between 1 and 2 in figure 3 of the drawings. So, the annular groove is old and appears in the old art in both the interior and exterior form.

The characteristics of the elastic packing as set forth in claim 3 of the patent show it to consist of "a free cylindrical part frictionally enclosing the unthreaded pipe end and having a flange frictionally retained in the groove of said sleeve". In McGowan, at K in figure 3 of the drawings, is shown his packing which he calls in his specifications a "gasket or cushion M", within the annular groove K, and which he says is securely fastened in the groove by pressure or by original formation with the flange. (Page 1, Column

2, Paragraph 3 of the specifications.) His flange is reversed and extends inwardly rather than outwardly of the gasket or packing; and the free cylindrical part does not enclose the unthreaded pipe end, but abuts a shoulder. In Jones we find in his specifications the gasket which he describes as having a base flange wherefrom a flexible part protrudes; and in the structure he discloses this flexible part fits within the male member instead of frictionally enclosing the end thereof. In other words, the same parts, but reversed in their operation. Close does not use the flange gasket or packing, but uses the "U" packing instead. (Figure 1) Berry discloses the flange packing at o in figures 3 and 4 of the drawings frictionally enclosing the part L and also susceptible of closing upon the part S in reverse action. Anderson uses the "U" packing as distinguished from the flange packing. Serrell discloses the flange packing and describes it in his specifications. (Page 1, Lines 64 to 71) It frictionally encloses the unthreaded part a of the faucet (figure 2 of the drawings). So, the flange packing and its frictional retention in the groove of the sleeve and its characteristic of frictionally enclosing the unthreaded pipe end is old.

The only remaining characteristic disclosed in claim 3 of the patent in suit is "means for hingedly securing said sleeve on the pipe having the unthreaded end". McGowan discloses this characteristic in two places in his patent, between A and B and between B and C in figure 1. Jones discloses a lock (figure 2, at 7, 8, 9, 10, 12 and 13 of his drawings) and he de-

scribes this in detail in his specifications (Lines 65-70, Page 1). Except that it includes the spring 10, it is very like the lock exemplified upon physical exhibits 3 and 48. Close employed no lock. Gorter discloses a very complicated locking device which he is careful to state in his specifications will not interfere with the rotary movement of the joint. In other words, it leaves flexibility. Berry provides a somewhat complicated locking device which permits full flexibility of the joint (i. e. hinged) which he describes at length in his specifications. (Page 2, Lines 18 to 29) Anderson provides a trunnion locking device at 9 of figure 4 of his drawings, and describes it briefly in his specifications. (Page 1, Line 54) Serrell provides a rigid locking device through the medium of the set screws, 6 in his figures 1 and 2, though by manual application to these set screws by a screw driver, his joint can be made movable while in use and service. So, recapitulating, all of the elements described in claim 3 of the patent in suit are in themselves old; they appear in even that limited portion of the prior art which has here been admitted in evidence in varied combinations; and it assuredly required no inventive genius to reassemble known factors commonly used together in the older art to arrive at the result described in claim 3 of the patent in suit. Aggregation only is involved. All of the parts, of necessity, produce their several results in the old and settled manner, as may be readily observed from their uses by prior inventors; and no new or useful result which is a joint product of the elements of

the combination and something more than the aggregation of the old results is involved. And under these circumstances, there is no invention.

As said by the Court in *Wood vs. Peerless Motor Car Corp.*, 75 Fed. (2d) 554 at Page 557 (C.C.A. 6, 1935)—and the language of the Court is exactly designed to describe the situation here before this Court—

“All that is here shown is a combination of elements old in the art, and combined in an old environment. It was no more than a judicious selection from the devices in the prior art, each designed and utilized to accomplish its individual purpose at a time and in a place where such function is necessary for the operation of the whole. This has been repeatedly held by this Court not to constitute invention.”

See also to the same effect:

Powers Kennedy Corporation v. Concrete M. & C. Co., 282 U.S. 175, 186, 75 L. Ed. 278, 286 (1930).

Keystone Driller Co. v. Northwest E. Corp., 294 U.S. 42, 50, 79 L. Ed. 747, 752 (1935).

Hartman Furniture and Carpet Co. v. Banning, 59 Fed. (2d) 129, 131 (C.C.A. 7) (1932).

Pickering v. McCullough, 104 U.S. 310-317-318 (1881).

(2) This specification is covered by the argument on the foregoing point, excepting as to the matter of anticipation. On this point, reference is made to the patent to Jones, Exhibit 27 (Page 395, Transcript of Record); and here, we have all of the elements enumerated in claim 3 of the patent in suit. Referring to

figure 2 of the Jones drawings, and as amplified by his specifications, we find a hose joint in connection with hose, one of the ends of the joint (No. 19 in Figure 4 of the drawing) having the unthreaded end, the rigid coupling sleeve for coupling the ends of the coupling (figure 14 of Figure 3 of the drawings) into which the unthreaded end extends, the interior annular groove in the inner surface (between figure 15 and the end of the part 19 in figure 2 of the drawing) the packing of elastic material (figures 21 and 22 in figure 5 of the drawings) in the coupling sleeve consisting of a free cylindrical part 21 which frictionally engages in the unthreaded pipe end from the inner instead of from the outer diameter, the packing having the flange 22 frictionally retained in a groove in the sleeve and means for hingedly securing the sleeve on the unthreaded end (figures 7, 8, 9, 10, 12 and 13 in figure 2 of the drawing). Variant factors are:

1. The coupling is a hose coupling, not a pipe coupling. This factor has been discussed.

2. The elastic packing engages the unthreaded pipe end from the inner diameter instead of upon the outer diameter, as disclosed in claim 3' of the patent in suit.

The result, so far as the packing is concerned, is the same; for either from the inner diameter or the outer diameter, the packing still seals the joint by the application of fluid pressure.

Mere reversal of parts producing no new result does not constitute invention.

Hamilton Beach Manufacturing Co. v. P. A. Geier Co., 230 Fed. 430, 437 (C.C.A. 7) (1916).

Penfield v. Chambers Brothers Co., 92 Fed. 630, 651 (C.C.A. 6) (1899).

Sax v. Taylor Iron Works, 30 Fed. 835, 837, C.C., D. N.J. (1887), Aff. 199 U.S. 485, 37 L. Ed. 964.

So, also, a mere reversal of movement of the same parts of an old device does not constitute invention if the reversal is made without change of parts or the function of parts.

Bryant Electric Co. v. Electric Protection Co., 110 Fed. 215, 217, C.C. E.D. Pa. 1901.

It becomes obvious that upon the reference to Jones alone, and had the trial court not ruled as he did concerning admissibility, when concerning anticipation, of prior patents for the coupling of hoses, claim 3 of the patent in suit must have been held invalid for anticipation, and this litigation would be at an end.

The Berry patent, Exhibit 36, discloses the pipe joint in connection with pipes, one of which has an unthreaded end, the rigid coupling sleeve, the flange packing (with flange reversed), the annular groove, this time on the exterior of the reduced portion of the pipe extending into the bell, the packing of elastic material having a reversed flange frictionally retained in the groove and, in the form of a universal joint, means for hingedly securing the sleeve on the pipe having

the unthreaded end. In other words, in this structure, all of the elements of claim 3 of Lanninger are present, though some of the parts are reversed. The Berry patent issued February 5, 1918.

So, when all is said and done, the patentee Lanninger did nothing more (and this is true of all of the claims of the patent, including claim 3) than to assemble old and known elements previously assembled in varied (and, in the case of Jones, practically the identical) combinations, all employed for the same general purpose, in what he designated as his "invention". And such procedure on the patentee's part is far from measuring up to the standard set by the courts as the measure of invention. The following quotation from the language of the court in *General Motors Corporation v. Preferred Electric & Wire Corporation*, 109 Fed. (2d) 615, 616 (C.C.A. 2) 1940, though proceeding on the "flash of genius theory", sets a far higher standard:

"They made and tried out a great many different forms, and came down at last to that which seemed to stand up the best. At least there is no evidence that any higher abilities were demanded than intelligent, well-trained and persistent experiment, acting in the light of the defects which past experience had developed. Perhaps, such qualities are as well worth a patent as sudden flashes of genius; perhaps, indeed, in the long run they are more deserving; but the prize does not go to success so achieved; something more out of the common is demanded."

In *Hailes v. Van Wormer*, 20 Wallace 353, 368, the court says:

“It must be conceded that a new combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made. But the results must be a product of the combination, and not a mere aggregate of several results each the complete product of one of the combined elements. Combined results are not necessarily a novel result, nor are they an old result obtained in a new and improved manner. Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention.”

In the devices described in claim 3 of the patent in suit, the spigot end of the pipe still enters the bell, the packing seals the joint permitting movement, and the locking means prevents the parts from blowing apart in use. Each element still performs its own and old functions in its old and own way; and nothing new results. It is not even here necessary to apply in its entirety the “flash of genius” test laid down in *Cuno Engineering Corporation v. Automatic Devices Corporation*, 314 U.S. 84, 90, 91, 92.

Turning now to the “usefulness” of the patented device, we find that the appellees have in evidence as their Exhibit 70 a model of the combination disclosed by claim 3 of the patent in suit; and both appellants and appellees concede this exhibit to be a correct model exemplifying the disclosures of the said Claim 3 and of the drawings of the patent in suit. It is a heavy model,

well and expensively made. But it carries with it obvious evidence of the reasons why it could not succeed commercially from the standpoints of its weight and the expense involved in casting and machining the metal parts. And it appears from the stipulations and admissions of counsel for the appellees that no more than half a dozen similar couplers were ever made (Page 332, Transcript of Record).

The appellee, California Corrugated Culvert Co., however, has made, as appears by the stipulation of counsel (Page 333, Transcript of Record) and sold many thousands per year of couplers embodying the characteristics of the Exhibit 17. It is because of this fact that the appellees claim utility and the resulting commercial success for claim 3 of the patent in suit. And, if the Exhibit 17 does in fact exemplify in concrete form the disclosures of claim 3 of the patent in suit, then the appellees are justified in such contention. If it does not exemplify in concrete form the disclosures of claim 3 of the patent in suit but does exemplify instead the various elements described in claim 3 of the patent in suit *less the flange* packing there described, and substitutes for such flange packing another and different instrumentality, then there has never been a reduction to actual use or any beneficial or commercial employment of the combination described in claim 3 of the patent in suit; and it follows by necessary reasoning that the device described in such claim of the patent has not been useful and so was not initially the subject matter of invention with-

in the language of the statute, and so the claim is but a paper claim and is now void for lack of utility. And lack of commercial success goes far to discredit the value of the "invention". *Landry v. Rockwell*, 45 Fed. (2d) 89. C.C.A. 1, 1930.

Therefore, we come to consider whether or not Exhibit 17 does indeed portray in concrete form the various elements disclosed by the language of claim 3 of the patent in suit. It may be conceded that it does portray all of those elements excepting the "flange" packing. On this point, the witnesses Vale and Hanson maintain and insist that the packing exemplified in Exhibit 17 is indeed a "flange" packing. Confronted with the Exhibits 97, 98, 99, 100, 101, 102, 103 and 104, the witness Vale squirms through a very unconvincing discourse (Pages 146 to 162, inclusive, Transcript of Record) to the effect that a "flange" packing is a "U" packing and a "U" packing is a "flange" packing; and the witness Hanson takes refuge in a sudden lack of exact familiarity with trade designations of packings when this subject comes up for discussion (Pages 364 to 366, Transcript of Record). The witness McDougall (Pages 226 & 227, Transcript) testifies without qualification that the packing exemplified in the Exhibit 17 is not a "flange" packing, but is a "U" or "V" packing. It remains but for the court to compare the packing in Exhibit 17 with the cuts and cross sections of "U" packings as disclosed in Exhibits 46A to 46F, inclusive and 97 to 104, inclusive, to arrive at the actual fact. The packing is a "U" pack-

ing and not a "flange" packing; the combination exemplified in physical Exhibit 17 which is the commercially successful product does not include the "flange" packing, one of the essential elements of claim 3 of the patent in suit; and any claims for commercial success of the "invention" of the patentee Lanninger must rest in the half dozen couplers which it is conceded have at some time in the past been made to the model of Exhibit 17 and which actually incorporated in their structure the flange packing. The patent is but a paper patent.

The witness Hanson (Pages 359, 360, 367 and 368, Transcript of Record) gives a reason for the variance. He does not say that it proved impracticable in fact to build couplers incorporating all of the elements of claim 3 of the patent in suit on a commercial scale; but he does say that because of the rolling processes involved in manufacture, it proved more practicable to build couplers employing a different type of packing, namely that exemplified in Exhibit 17. A comparison of Exhibits 70 and 17 and the obvious differences in manufacturing requirements necessary to produce them well bears the witness out in this particular.

This state of facts makes apropos here the statement of the Court in *Elvin Mechanical Stoker Co. vs. Locomotive Stoker Co.*, 286 Fed. Page 309 (311) C.C.A. 3, 1923:

"The Pennsylvania Railroad which has a shop right to manufacture it, has made but one, and there is no proof that the plaintiff company,

which now owns the patent, or the patentee, have ever manufactured any, although the device is some 14 years old; the patent having been applied for in 1908. Such being the fact, we are justified in holding that Gee will receive all the patent protection to which he is entitled by confining his claims to the particular structure he disclosed and to the mechanical equivalents of its parts, and declining to construe his claims in any broad way to cover other devices whose commercial success in the art lies, *not in the fact that they adopted his disclosures, but that they departed from them.*"

The same rule is stated by this Court in *Wire Tie Mach. Co. vs. Pacific Box Corp.*, 102 Fed. (2d) 543 (Page 556) C.C.A. 9 (1939).

SPECIFICATION III.

1. Turning now to the prosecution in the patent office of Lanninger's application for letters patent, it will first be observed that this prosecution endured from the filing of the application to the issue of the letters patent, for between six and seven years (October 8, 1923 to February 18, 1930).

In the original petition (5th page, but numbered "1" of Exhibit 45, the file wrapper and contents upon the Lanninger patent application), the patentee states that the "salient feature" of the invention consists in that the coupling sleeves are rigid and have cups of elastic material, the neck of each cup fitting tightly on the corresponding pipe end, said cups having further *each a flange which is clamped in the casing*. In the very inception of his application, he specifies the

flange as a part of the *salient feature*. Later, in the same paragraph, he describes the flange. His description follows:

“The very strong vertical flange on the packing cup permits of a specially simple fixation as it is inserted and clamped in a groove of the coupling sleeve.”

So, Lanninger's flange was *robust, strong, vertical and clamped* in a groove of the coupling sleeve. This was his invention as he came with it to the patent office. True, he says that the invention is not confined to any strict conformity with the showing of the drawings, but may be embodied in any manner which does not make a *material* departure from the *salient* feature of the invention. And, in his own words, the salient feature of the invention incorporated the very *strong, vertical flange, clamped* in a groove of the coupling sleeve.

We follow him now through his more than six year course through the patent office (see file wrapper and contents, Exhibit 45) and always as he proceeds, we discover that he continues the stressing of that flange.

It is true that the examiner, in the action dated March 6, 1924, cites the Jones and Berry patents with, notably, other patents on hose connections; but he cites these, in his own words, only in a “cursory” manner.

When we come to the action of the examiner dated August 23, 1928, we discover that claims 12 and 13

are rejected on Anderson. Of these claims, claim 13 is the present claim 3 in suit. In response to this action, the applicant, by his filing of February 12, 1929 expressly differentiated between Anderson and his own combination. He states that Anderson does not show a packing having a flange. This is true, for if one examines the drawing, figure 11 of the Anderson patent (Page 438, Transcript) one discovers that Anderson used a "U" packing, as does the alleged infringing device in the litigation now before the court. Anderson, in his specifications, states that "any suitable packing may be used but preferably a cup-shape packing 7". He goes on to delineate a spring for expanding the walls of the packing; and on his exemplification in figure 11 of the drawing, he shows a "U" packing with the spring on the interior thereof. The patentee says in so differentiating:

"Anderson, for instance does not show the unthreaded end of the pipe extending into the rigid sleeve. Furthermore, he does not show *a packing having a flange clamped in the sleeve* and a free portion extending into the sleeve and frictionally engaging the unthreaded end of the pipe. It is obvious that this construction produces a joint in which the packing means is enclosed in the sleeve, and yet, at the same time, a wide amplitude of oscillation is permitted by the free construction of the unthreaded end and of the packing itself, relative to the sleeve.

"Claims 12 and 13 both define these 'novel' features very definitely. Attention is called to the examiner that claims 12 and 13 are generic to the same modification of the invention, for while claim 13 defines a sleeve as being formed with the

groove *frictionally retaining the flange of the packing*, claim 12 defines the sleeve as including means for clamping the flange in the sleeve. A glance at figure 6 will show that the sleeve is formed with the annular groove receiving the packing and, at the same time, it is formed in two parts, so that the packing may be clamped in the groove.”

In other words, in the patent office, and to differentiate from Anderson, Lanninger stressed the distinction between his flange packing and Anderson’s “U” packing in order to avoid rejection on the reference.

Contrast this distinction made by the patentee, in order to secure the issue of his patent over the Anderson reference, with the testimony of the appellees’ witnesses Vale and Hanson in the case at bar. At pages 125 and 140 to 171, inclusive, the witness Vale insists that practically any type of packing is a “flange” packing and certainly his version of a “flange” packing is wide enough to include the packing of Anderson which the patentee Lanninger was so careful to differentiate as being a different instrumentality to his own “flange” packing in order that his patent might issue. And referring to Exhibit 17, the packing wherein is practically identical to the packing disclosed by Anderson (Figure 11 at page 438, Transcript of Record) the witness Hanson insists (Page 357, Transcript of Record) that the packing in Exhibit 17 has a flange and again, on page 366, and referring to the same packing, the same witness insists that the same may be called a “flange” gasket “because it has a flange on it”. At best, it must be

said that the construction placed by these two witnesses is 100% at variance with the construction adopted by the patentee when he differentiated his patent from Anderson in order to secure its issue.

And the representatives of the patentee now seek to fasten infringement upon these appellants because of their very use of that same "U" packing upon which the patentee differentiated his alleged invention from Anderson. This they may not do.

A like situation arose in—

Directoplate Corp. v. Donaldson Lithographing Co., 51 F. (2d) 199, 202.

"Koppe was not a pioneer in the field of vacuum-pressure frames for photographic printing. Like all improvers, he was, and is, entitled only to a narrow range of equivalents. He has disclosed no broad, generic invention, unless it be in the use of the vacuum-pressure frame in a photo-composing machine, and this combination is not claimed. He has been specific in matters of number, form, structure, relationship, and function of the elements of his claim (as the condition of the art required him to be), and we do not think that he can now be permitted to depart from the plain meaning of the language he has adopted, or to claim for such language a broad and generic construction. Compare *Lektophone Corp. v. Rola Co.*, 282 U.S. 168, 171, 51 S. Ct. 93, 75 L. Ed. 274. Viewed from another angle, intent and the inventor's own appraisal of the nature of his invention are of great importance. In *D'Arcy Spring Co. v. Marshall Ventilated Mattress Co.*, 259 F. 236, 240, this court said: 'Where the claim defines an element in terms of its form, material, location or function, thereby apparently creating an express

limitation, where that limitation pertains to one inventive step rather than to its mere environment, and where it imports a substantial function which the patentee considered of importance to his invention, the court cannot be permitted to say that other forms, which the inventor thus declared not equivalent to what he claimed as his invention, are nevertheless to be treated as equivalent, even though the court may conclude that his actual invention was of a scope which would have permitted the broader equivalency.' This statement has peculiarly forceful application to the present case. Even though we were to conclude that Koppe might have claimed a broad monopoly in the use of vacuum-pressure frames, of whatever structure, in a photo-composing machine, he has voluntarily limited himself to a specific construction of clearly defined elements all pertaining to the inventive step as he then understood it. Such limitation is not the less effective because voluntary or inserted unnecessarily. *Firestone Tire & Rubber Co. v. Seiberling* (C.C.A. 6), 257 F. 74, 78, 79; *Lakewood Engineering Co. v. Stein* (C.C.A. 6) 8 F. (2d) 713, 715; *Vanderveld v. Rollman & Sons Co.* (C.C.A. 6), 28 F. (2d) 948, 951. That which is not literally within the claim does not infringe."

2. The record discloses (Exhibits 87 and 88 and testimony of McDougall (Pages 237 to 254, Transcript of Record) that in the year 1938 and while the Appellee, California Corrugated Culvert Co., was licensee under the Pierce patent 1945293, the said Appellee made a careful check through its patent attorneys to determine whether or not the patent in suit would be infringed through the manufacture and sale of pipe joints or couplers responding to the claims of the Pierce patent and including an interior locking means. The said appellee determined that such would not be the

case, and thereupon prepared and forwarded to George F. McDougall, Patent Attorney for the said Pierce, a certain proposed form of claim for the new Pierce invention (Exhibit 88-A). No patent issued on this invention which is exemplified by Exhibit 82 and sub-numbers, because, apparently, Pierce's idea was already patented (Page 252, Transcript of Record); but the fact remains that the said appellee here defined its field under the claims of the patent in suit as not including the Pierce coupler with the addition of *interior* locking means. The proposed locking means, which the said appellee itself described in its proposed form of claim was hinged; and as before set out, the change of position of the parts from interior to exterior is of no moment. Bearing this in mind, it may be said that the said appellee here defined the claims of the patent in suit as not extending to the Pierce coupler as equipped with hinged locking means. And this definition on the part of the said appellee, California Corrugated Culvert Co., was communicated by the said McDougall to the appellants herein prior to the notification of infringement, Exhibit 90. Proof was proposed that the appellants herein acted upon such information so received by them (Pages 243, 324 and 326, Transcript); but the trial court finally ruled out all evidence along this line and declined the final proffered proof, holding that in no event would it avail the appellants herein (Pages 324 to 327, inclusive, Transcript of Record).

The patentee's appraisal of the nature of his invention is of great importance.

- A. O. Smith Corporation v. Lincoln Electric Co.,
82 Fed. (2d) 226, 229, C.C.A. 6 (1936).
Wood v. Peerless Motor Car Corp., 75 Fed. (2d)
554, C.C.A. 6 (1935).

The acts and conduct of an owner of a patent may also give a construction to a claim which will avoid infringement. For instance, where the patentee or his assignee had for a number of years placed a certain construction on a claim with knowledge that the defendant during that time had been selling a device for a similar purpose to that of complainant but which did not infringe the claim as so construed, complainant was held to be estopped from claiming infringement.

- Westinghouse Electric & Manufacturing Co. v.
Wagner Co., 129 Fed. 604, C.C. Mo.
McGill v. Whitehead & Hoag Co., 137 Fed. 97
C.C. N.J.

These cases refer to the "patentee" or "assignee", but in this instance it is the exclusive licensee under the patent for the purposes of the use on account of which infringement is here charged who construed the claims of the patent and who must be bound by his construction inasmuch as the use and sale complained of falls within the scope of his license.

3. The trial court's findings are to the effect that the packing element in the accused device performs the same function in the same manner as does the packing element described in claim 3 in the patent in suit.

The range of equivalents to be accorded a patent depends upon and varies with the degree of invention.

Continental Paper Bag Company v. Eastern Paper Bag Company, 210 U.S. 405, 52 L. Ed. 1122 (1908).

The range of equivalents to which an inventor is entitled is broad in an uncrowded art and narrow in a crowded one.

Page 1213, Volume 2 Dellar's Edition Walker on Patents (1937 Edition) and authorities there cited.

A range of equivalents will not be allowed which will give to a claim an enlarged scope expressly denied to it in the patent office.

Page 1214 Dellar's Edition Walker on Patents, Volumes 2 and authorities there cited.

In this instance, Lanninger secured issue of his patent only by differentiating his "flange" packing from the "U" packing disclosed by Anderson. He confined himself to the single form of packing in order that his patent might issue at all. Despite this fact, and despite the plain and unambiguous language of claim 3 prescribing the form of his packing, the court now extends that language to include the very form which Lanninger disclaimed in the patent office in order to secure issue of his patent.

And, in this instance, an additional factor presents itself. The testimony of the witnesses Finkbeiner (Pages 257, 269 and 271 and 275 to 289, Transcript of

Record) and McDougall (Pages 207 to 210, and 221 and 222, Transcript of Record) discloses that the "U" or "V" packing operates by hydraulic pressure at both of its edges, whereas the flange packing operates through the imposition of hydraulic pressure on its thin or free end and by the application of *mechanical* pressure upon the flange. There is a distinct difference in the means of operation between the two types. The Appellee's witness, Baldwin Vale, describes the operation of the flange packing (Page 115, Transcript of Record) when he says "It is *wedged* up in there, and the connection of the wedge is frictional." And he is correct in so doing; and the operation of the wedge is a mechanical operation and not a hydraulic operation. The witness McDougal confirms appellee's witness Vale on this point (Page 222, Transcript of Record). It is true that in other parts of his testimony the witness Vale discloses other ideas of the operation of the flange packing; and the witness, Hanson, decides that the operation of the flange packing and the "U" or "V" packing is identical. There is a conflict; but it can be resolved by reference to the ideas of the patentee Lanninger himself. In five of his six claims he resorts to the mechanical process of clamping the flange. In the sixth claim, that here in suit, he "frictionally retains it". And even the word "frictionally" connotes the application of mechanical as distinguished from a hydraulic pressure.

Where a claim for combination specifies a certain element as entering into it, such element is thereby

made material and the court cannot declare it immaterial.

Fay v. Cordesman, 109 U.S. 408, 420, 27 L. Ed. 979 (1893).

And where a combination of old elements is relied on for patentability there will be no infringement if any one of the material parts of the combination is omitted and the patentee will not be heard to deny the materiality of any element included in his combination claim.

United States Ozone Co. v. U. S. Ozone Co. of America, 62 Fed. (2d) 881, 889, C.C.A. 7 (1932).

Adam v. Folger, 120 Fed. 260, C.C.A. 7.

Vance v. Campbell, 66 U.S. (1 Black) 427, 17 L. Ed. 168.

Union Water Meter Co. v. Desper, 101 U.S. 332, 337, 25 L. Ed. 1024.

McClain v. Ortmyer, 141 U.S. 419, 423, 35 L. Ed. 800.

Texas Rubber & Specialty Corporation v. D. & M. Machine Works, 81 Fed. (2d) 206, 208, C.C.A. 5 (1936).

To sum up: the patentee Lanninger is charged with knowledge of the trade name of his "flange" packing as of the time when he entered the patent office with his application for patent, for that trade name was well established in the American packing industry (See Exhibits 46A to 46F, inclusive, 97, 98, 99, 100, 101, 102, 103 and 104; and the testimony of the witnesses Vale (Pages 146 and 163, Transcript of Record), McDougall (Pages 206 & 207, Transcript of Record) and

Finkbeiner (Pages 256, 267 and 268, Transcript of Record). And in addition to being charged with knowledge of such trade name, he actually had such knowledge and he employed that knowledge to differentiate between his combination, employing the "flange" packing and the combination of Anderson which employed the "U" packing.

In *Smith v. Magic City Kennel Club*, 282 U.S. 784, 75 L. Ed. 707, the court said:

"Where a patentee has narrowed his claim in order to escape rejection he may not 'by resort to the doctrine of equivalents' give to the claim the larger scope which it might have had without the amendments, which amount to disclaimer".

And a patentee cannot claim as equivalent something which he relinquished to secure his patent, despite the fact that the invention is a meritorious one.

John I. Paulding, Inc. v. Leviton, 45 Fed. (2d) 125, C.C.A. 2 (1930).

These cases refer to claim modifications, though the same principles are here applicable; but in *Good-year Dental Vulcanite Co. v. Davis*, 102 U.S. 222, the Supreme Court said:

"This construction of the patent is confirmed by the avowed understanding of the patentee, expressed by him, or on his behalf, when his application for the original patent was pending. We do not mean to be understood as asserting that any correspondence between the applicant for a patent and the Commissioner of Patents can be allowed to enlarge, diminish or vary the language of a pat-

ent afterwards issued. Undoubtedly, a patent, like any other written instrument, is to be interpreted by its own terms. But when a patent bears on its face a particular construction, inasmuch as the specification and claim are in the words of the patentee, it is reasonable to hold that such a construction may be confirmed by what the patentee said when he was making his application. The understanding of a party to a contract has always been regarded as of some importance in its interpretation."

In *Quick Action Ignition Co. v. Maytag*, 39 F. (2d) 595, (C.C.A. 8) the court said:

"The above proceedings in the Patent Office convince that this patent was allowed and accepted only upon the conclusion that an essential element of novelty in the combination was the overhanging armature core * * * To a combination with that element so limited the patentee is therefore bound."

See also

Automatic Appliance Co. v. McNiece Motor Co.,
20 Fed. (2d) 578 (C.C.A. 8).

Aleograph Co. v. Electrical Research Products,
55 F. (2d) 106 (C.C.A. 5).

General Chemical Co. v. Aluminum Co. of America, 11 F. (2d) 810 (D.C., W.D. Pa.) Affirmed C.C.A. 3, 11 F. (2d) 813.

Ladd v. Walker, 7 F. (2d) 72 (C.C.A. 3).

Freeman Electric Co. v. Weber Electric Co., 262 Fed. 769 (C.C.A. 3) from which is quoted:

"But, even assuming that the words 'when telescopically applied' are susceptible of a construction sufficiently broad to include the bayonet joint locking movement, the remarks, filed in the Patent Office by the patentee or on his behalf, dis-

tinguishing the Weber locking movement from that of Kenney, disclose that either Weber always intended and understood that these words should bear their usual meaning, and thus exclude the Kenney movement, or under stress of the Patent Office rejection he elected to so restrict their meaning. In either event the result is the same, namely, that having thus limited his claims to exclude the bayonet joint movement of Kenney, he is not now entitled, through the aid of the doctrine of equivalents or otherwise, to a construction that would embrace it."

Gottschalk Manufacturing Company v. Springfield Wire & Tinsel Company, 74 F. (2d) 583 (C.C.A. 1) from which is quoted:

"A patentee will not be permitted to repudiate a construction which he has placed upon a claim in a communication with the Patent Office in order to obtain the allowance of it."

In,—

Lunati v. Barrett, 104 F. (2d) 313, 316 (6th Cir.),

the court said:

"The appellant argues that even though we consider this a limitation there is no estoppel by reason of the amendment because other limitations were therein incorporated, including narrow spaced parallel rails, arranged on opposite sides of the supporting member, and secured at their ends near the centers of the rails, the latter being relatively long and free from extraneous elements from their ends to the extensions of the supporting members. We are, however, dealing with a combination, the elements of which were old, precisely limited to avoid prior art. If the defendant does not have this combination he does not infringe.

“The claims in suit must be narrowly construed within the principles so often applied in this court that where claims define an element in terms of form, location or function, thereby creating an express limitation, where that limitation pertains to the inventive step and imports a substantial function which the patentee considered of importance, the court cannot be permitted to say that other forms which the inventor thus declared not equivalent are so to be treated. *D’Arcy Spring Co. v. Marshall Ventilated Mattress Co.*, 6 Cir., 259 F. 263, 240; *Hollingshead Company v. Bas-sick Mfg. Co.*, 6 Cir., 73 F. (2d) 543, 548; *Directo-plate Corp. v. Donaldson Lithographing Co.*, 6 Cir., 51 F. (2d) 199, and our recent decision in *Val-jean v. Perfection Stove Co.*, 6 Cir., 103 F. (2d) 60. Whether our conclusion be based upon estop-pel in patent office proceedings or upon a limita-tion voluntarily inserted in the claims to avoid prior art seems to us unimportant. The result in claim construction is the same.”

4. Section 4888 of the Revised Statutes requires the inventor to disclose his invention in plain language; and it is obvious that the purpose of the statute is two-fold: first, to set aside to the inventor as his own that which he has actually invented; and, secondly, to advise the public at large not only of the extent of the inventor’s domain in which it may not trespass, but also the extent of that field which remains open to the general use.

See *General Electric Co. v. Wabash Clients Corp., et al.*, 304 U.S. 364, Page 369.

“The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of a patent will be dedicated ul-

timately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' The claims 'measure the invention'."

In the instant case, as developed in the prior discussion, the patentee Lanninger did define his field of domain. That field he circumscribed to the use as one element of his combination of a "flange" packing. And a "flange" packing was a definitely known quantity. The trial court, to arrive at the interlocutory decree herein, as rendered, was obliged to disregard the plain claim language of Lanninger which, in the course of his long course through the patent office, the patentee had particularly defined and differentiated, and to determine that the patentee did not mean what he said when he so proudly described his "flange" packing but that, in fact, apparently, patentee was claiming practically any packing at all as one of the elements of his combination.

In *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 419, 52 L. Ed. 1122, the Supreme Court says:

"The claims measure the invention"

and

"The claim actually made by the patentee is the measure of his right to relief." *Peterson v.*

General Seafood Corporation, 66 Fed. (2d) 459, 463. C.C.A. 1 (1933).

And in *Cimiotti Unhairing Co. vs. American Fur Refining Co.*, 198 U.S. 399, 49 L. Ed. 1100, the Supreme Court speaks thus :

“In making his claim, the inventor is at liberty to choose his own form of expression; and while the courts may construe the same in view of the specifications and the state of the art, they may not add to or detract from the claim. And it is equally true that as the inventor is required to enumerate the elements of his claim, no one is an infringer of a combination claim unless he uses all the elements thereof.”

It is obvious that the trial court was forced to ignore claim language in arriving at the decree entered and, in so doing, was guilty of error.

The distinction between the “U” or “V” packing employed as an element of the accused devices herein and the “flange” packing of Lanninger has been previously discussed and will not be here repeated.

CONCLUSION

It becomes obvious that the trial court erred in declining to consider in anticipation of the patent in suit prior patents for hose couplings; and on this account alone and if claim 3^d of the patent in suit could indeed be held valid at all, it is necessary that the decree appealed from be reversed and the cause remanded in order that prior patents involving hose

connections may be introduced in anticipation of the patent in suit.

But more than this, it is also obvious that in assembling the combination claimed as patented in claim 3 of the patent in suit the patentee did nothing but assemble known elements, all similarly employed in the prior art, into an aggregation involving little or nothing of skill, and certainly nothing of invention; but even when so assembled and claimed the end product was not useful and, so, was unpatentable on both counts, and the claim is void.

Further, the appellee, California Corrugated Culvert Co., had in the past, and after careful examination of all of the factors involved, by its patent counsel, defined instrumentalities of the exact manufacture of the accused devices excepting only that these instrumentalities included interior rather than exterior locking means as being without the disclosures in the field of protection of claim 3 of the patent in suit, and that fact had been made known to the appellees herein and they had acted in the light thereof and, so, the appellants herein are now estopped to assert infringement.

Further, the patentee Lanninger in the course of his application in the patent office defined and delimited the scope of his claim 3 to include a flange packing, and differentiated that flange packing from a "U" packing in order to secure the allowance of his patent; and he and his successors in interest are now estopped

to assert claim 3 of the patent in suit in scope sufficient to include that which the patentee in the patent office disavowed as a part of his combination; namely, the inclusion as one element of the claim of the "U" packing.

Further, the trial court erred in ignoring the plain and unambiguous language of claim 3 of the patent in suit, defined as that language had previously been, as disclosed by the file wrapper, to exclude a "U" packing, and by substituting for the express language of the claim of the patent in suit a judicial determination amounting actually to a judicial reissue of the patent by reading the language of the patent in suit to include, in substance, any type of packing, either hydraulically or mechanically activated.

Respectfully submitted,

J. S. MIDDLETON,

Attorney for Appellants.

Service of the within Brief and receipt of three copies thereof are acknowledged at Portland, Oregon, this day of July, 1943.

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Of Attorneys for Appellee, California Corrugated Culvert Co.

Service of the within Brief and receipt of three copies thereof are acknowledged at Portland, Oregon, this day of July, 1943.

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Of Attorneys for Appellee, Leo T. Crowley, as Alien Property Custodian of the United States.

